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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,863	07/24/2001	Sae-Young Yoon	KPLO 7033	6203

321 7590 06/30/2006		EXAMINER
SENNIGER POWERS		LASTRA, DANIEL
ONE METROPOLITAN SQUARE		
16TH FLOOR		ART UNIT / PAPER NUMBER
ST LOUIS, MO 63102		3622

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 July 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>06/25/02</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-10 have been examined. Application 09/912,863 (METHOD FOR TRANSMITTING ADVERTISEMENTS VIA ELECTRONIC MAILS) has a filing date 07/24/2001 and foreign priority 09/07/2000.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1-10 recite wining a prize. However, the Applicant's specification and the claims do not explain how said prize is won and what is the meaning of said prize. The Applicant's claims also mentions ranking advertisements by click-rate, but Applicant's specification does not explain the meaning and how said click rate is determined. The Applicant's specification mentions about "displaying a prize advertisement menu of an interest field of a particular user in priority realizes more efficient advertisement with a high probability, and displaying in priority the prize advertisements lowest in click rates on a prize advertisement menu has an effect of securing the balance click rates between sponsor". Applicant's specification does not teach or explained about the meaning of balance click rate and how said menu is

created. Applicant's claims recite a correlation between advertisements' click rate and

priority placement. However, nowhere, in Applicant's specification is explained how said

click rate is used for priority and the meaning of said term "click rate".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Claims 1 and 2 recite "displaying questions

regarding the sender on the sender's web browser according to the above choice". Said

limitation is indefinite because it does not clearly teaches what is that is chosen. For

purpose of art rejection, said limitation would be interpreted as obtaining user's

preferences or a profile. Claims 1 and 2 recite "notifying the sender of whether he or she

wins a prize". Said claims do not explain how or why said prize is won. For purpose of

art rejection, receiving a prize would be interpreted as receiving a coupon. Claim 1

recites that a sender is sending a message to a sender. For purpose of art rejection,

claim 1 would be interpreted as a sender selecting advertisements. Claim 3 recites

"question of a upper and lower concept". For purpose of art rejection, said limitation

would be interpreted as a user indicating his preferences. Claim 8 recites "ranking and

sorting based on the click rates of the advertisements up to date". The Applicant's

specification does not teach the meaning of click rate and how is calculated. For

purpose of art rejection, said limitation would be interpreted as targeting advertisements

by user's profile or preferences. Claim 8 recites "displaying the constructed

advertisements on a web browser of the user, wherein the prize advertisement menu are provided to the user". Said limitation is indefinite because it does not explain what is a prize advertisement menu and what said menu comprises of. For purpose of art rejection, said limitation would be interpreted as targeting advertisements by user profile. Claim 9 recites "at positions from most visible to the less visible". Said limitation is indefinite because it does not clearly explain the meaning of "visible". For purpose of art rejection, said limitation would be interpreted as meaning targeting advertisements based upon user's profile. Claim 10 recites "order the advertisements from the advertisements lowest in a click rate to the advertisements highest in the click rate up to date". The Applicant's specification does not explain the meaning of click rate and how is used to rank advertisements. Applicant's specification teaches using a user's profile to target advertisements. Therefore, said limitation would be interpreted as meaning targeting advertisements based upon user's profile.

Claims 1 recites the limitation "enclosing the coupon " in 8, "the prize providing server" in line 14, "on the sender's tendency" in line 16. Claim 2 recites "the received coupon" in line 7, "the prize providing server". Claim 7 recites "the advertisement database" in line 7, "through the sorting". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over recommended-it.com article in view of Postrel (US 2004/0220854).

As per claim 1, recommended-it.com teaches:

A method for transmitting advertisements via electronic mails in which the advertisements are enclosed together with coupons on the internet, the method comprising steps of:

connecting to a web server for providing an electronic mail service by a sender who wishes to send an electronic mail, and preparing an electronic mail message (see page 1);

enclosing an offer with the electronic mail, and sending the electronic mail by the sender (see page 4);

choosing that the sender himself receives the email offer as well (see page 2 "email recipient").

displaying questions regarding the sender on the sender's web browser according to the above choice (see page 1, "fill a form");

storing in a database of the prize providing server the sender's answers to the questions as information on the sender's tendency (see page 1, "personalized email").

notifying the sender of whether he or she wins a prize by the prize providing server (see page 4 "free newsletter").

recommended-it.com does not teach that the offer is a coupon. However, Postrel teaches a system that target coupons to users via email (see paragraphs 16, 17 and

44). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the recommended-it.com system would email coupons to users, as taught by Postrel in order that said targeted email coupons serve as an incentive to said users to read and accept said emails.

As per claim 2, recommended-it.com teaches:

A method for transmitting advertisements via electronic mails enclosing the advertisements together with coupons on the internet, the method comprising steps of:

connecting to a web server for providing an electronic mail service by a receiver of the electronic mail and confirming an electronic mail message enclosing the received offer (see pages 1, 4),

choosing that the receiver receives an offer (see page 4);

notifying the receiver of whether he or she wins a prize by the prize providing server (see page 4 "free newsletter").

recommended-it.com does not expressly teach displaying questions regarding the receiver on a web browser of the receiver according to the choice and storing in a database of the prize providing server receiver's answers to the questions as information on receiver's tendency. However, Postrel teaches a system that target coupons to users via email (see paragraphs 16, 17 and 44). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the recommended-it.com system would email coupons to users, as taught by Postrel in order that said targeted email coupons server as an incentive to said users to read and accept said emails.

As per claim 3, recommended-it.com teaches:

The method as claimed in claim 1 or 2, but fails to teach wherein the questions are suitable for grasping personal preferences and purchase tendencies of the sender or the receiver, and the questions are in a hierarchical structure with questions of an upper concept and question of a lower concept. However, Postrel teaches a system, that target coupons to users via email based upon said users' preferences (see paragraphs 16, 17 and 44). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users would use the recommended-it.com system to send coupons to users via email, as taught by Postrel in order that said targeted email coupons serve as an incentive to said users to accept and read said emails.

As per claim 4, recommended-it.com teaches:

The method as claimed in claim 1 or 2, but fails to teach wherein the information on the tendencies of the sender or the receiver stored in the database of the prize-providing server is employed for target advertisements through electronic mails based on the information. However, Postrel teaches a system that target coupons to users via email (see paragraphs 16, 17 and 44). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users of the recommended-it.com system would email coupons to users, as taught by Postrel in order that said targeted email coupons serve as an incentive to said users to read and accept said emails.

As per claim 5, recommended-it.com teaches:

A method for transmitting advertisements via electronic mails enclosing advertisements together with coupons on the internet, the method comprising steps of:

receiving conditions for target advertisements from sponsors (see page 2);

analyzing whether there are users fit for conditions of the sponsors through the information on the user's tendencies stored in the database of the prize providing server by the method of claim 1 or 2 (see page 2 "friend or colleague"); and

recommended-it.com fails to teach enclosing the target advertisements of the sponsors electronic mail together with coupons and automatically transmitting the electronic mail to the users fit for the conditions, in case that the number of the users satisfying the conditions of the sponsors meets a predetermined number. However, Postrel teaches a system, which targets coupons to customers via email based upon said users' preferences and where said targeted coupons are numerically limited (see paragraphs 13, 16, 17 and 44). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users would use the recommended-it.com system to target coupons to users via email, as taught by Postrel in order that said targeted email coupons serve as an incentive to said users to accept and read said emails.

As per claim 6, recommended-it.com teaches:

The method as claimed in claim 5, but fails to teach in case that the number of the users satisfying the conditions of the sponsors does not meet the predetermined number, further comprising steps of preparing new questions capable of analyzing the conditions received from the sponsor; transmitting the prepared new questions to all the

users via electronic mails enclosing coupons; and storing in the database in the prize-providing server the answers of the users who response to the questions. However, Postrel teaches a system, which target coupons to users via email based upon said users' preferences (see paragraphs 16, 17 and 44), where said users' preference are obtained from answers obtained from said users to different questionnaires (see paragraphs 16 and 17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that users would use the recommended-it.com system to target coupons to users via email, as taught by Postrel in order that said targeted email coupons serve an incentive to said users to accept and read said emails.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Mankoff (US 6,868,426).

As per claim 7, Mankoff teaches:

A method for transmitting advertisements via electronic mails enclosing the advertisements together with coupons on the internet, the method comprising steps of:

connecting to a prize-providing server by a user; comparing and analyzing the tendency of the user stored in a user database of the prize providing server with the advertisements stored in the advertisement database (see col 6, line 55 – col 7, line 19);

constructing a priority order of advertisements fit for the tendency of the user according to the analysis through the sorting (see figure 8); and

displaying the constructed advertisements on a web browser of the user, wherein prize advertisement menus are provided to the user (see figure 8).

As per claim 8, Mankoff teaches:

A method for transmitting advertisements via electronic mails enclosing the advertisements together with coupons on the internet, the method comprising steps of:

connecting to a prize providing server by a user (see col 7, lines 5-20);

constructing a priority order of the advertisements to be provided to the user through ranking and sorting based on click rates of the advertisements up to date (see figure 5); and

displaying the constructed advertisements on a web browser of the user, wherein prize advertisement menus are provided to the users (see figure 5).

As per claim 9, Mankoff teaches:

The method as claimed in claim 7, wherein the step for constructing the order of the advertisements to be provided to the users arranges the advertisements at 15 positions from most visible to less visible on the prize advertisement menus in the order from the advertisements most related to the user's tendency to the advertisements less related to the user's tendency (see figure 5).

As per claim 10, <u>Mankoff</u> teaches:

The method as claimed in claim 8, wherein the step for constructing the order of the advertisements to be provided to the users through the ranking and sorting arranges the advertisements at positions from most visible to less visible on the prize advertisement menus in the order from the advertisements lowest in a click rate to the advertisements highest in the click rate up to date (see figure 8).
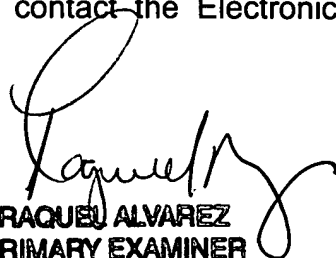
Conclusion

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
June 14, 2006

RAQUEL ALVAREZ
PRIMARY EXAMINER